

REMARKS

This Response is submitted in reply to the Office Action dated November 11, 2007. Claims 1, 3, 4-7, 9, 13, 15, 18, 20, 22-26, 28, 32, 34, 37-38, 40, 44 and 47 have been amended. Dependent claims 55 and 56 have been added. Claims 1, 18, 20, 37, 38 and 47 are in independent form. No new matter has been added by these amendments. A Petition for a One Month Extension of Time to reply to the Office Action is submitted with this Response. A Supplemental Information Disclosure Statement is submitted with this Response. Please charge Deposit Account No. 02-1818 for all fees due in connection with this Response.

Applicant refers to previously presented claims 1-54 in the Office Action dated November 11, 2007 as "Prior Claims".

Claim Rejections – 35 U.S.C. § 103

Independent Claim 1

The Office Action rejected Prior Claims 13, 6-14, 16-22 and 25-32 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,210,997 to Hughs-Baird, et al. ("Hughes-Baird"). Regarding such rejection, the MPEP, discussed below, recites that it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. As best understood by the Applicant, such rejection of Prior Claim 13 is a typographical error and should have been stated as a rejection of Prior Claims 1-3. Also, in the rejection of independent Prior Claim 1, the Office Action stated the following:

Hughs-Baird fails to disclose that [sic] However, the examiner believes that because Hughes-Baird contains the structural limitations of the disclosed instant application, the procedural application of the structural components of the device would have been obvious to one skilled in the art to perform as it is a simple matter of design choice.

Because of the Office Action's incomplete sentence, the Office Action does not provide a clear explanation for the basis of such rejection. Moreover, the Office Action relies on such statement for all other independent claim rejections. Accordingly,

Applicant requests withdrawal of the rejection. Alternatively, Applicant requests clarification of such rejection in a Non-final Office Action.

The MPEP supports Applicant's position. Section 706.02(j) of the MPEP states:

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. . . Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application. MPEP § 706.02(j).

Nonetheless, to advance prosecution of this application, Applicant has responded as best as the Applicant understands the rejections.

Regarding independent Prior Claim 1, the Office Action does not address the following elements: (a) "wherein each modifier is adapted to be associated with a plurality of activations of the reels"; (b) "activate the selected modifier for each of a plurality of subsequent activations of the reels that are associated with the selected modifier"; or (c) "apply the activated modifier to modify at least one function of the primary game for each of the subsequent activations of the reels that are associated with the activated modifier." Hughs-Baird does not anticipate nor render obvious such claimed subject matter. At least for the foregoing reasons, Applicant requests the withdrawal of such rejection of Prior Claim 1.

Independent Claim 18

The Office Action rejected independent Prior Claim 18 under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird. Regarding Prior Claim 18, the Office Action stated:

Re claim 18: The limitations of claim 18 have been fully met by the combination of the limitations of claim 1-17.

However, such combination does not address the following elements of independent Prior Claim 18: (a) "wherein each modifier is associated with at least one subsequent activation of the reels and at least one modifier is associated with a plurality of subsequent activation of the reels"; (b) "a triggering event associated with said primary game wagering game, wherein after the occurrence of said triggering event . . ."

; or (c) "the selected modifier is activated for the each of the subsequent activation of the reels that are associated with the selected modifier and the activated modifier to modify at least one function of the primary wagering game for each of the subsequent activation of the reels that are associated with the activated modifier." Hughs-Baird does not anticipate nor render obvious such claimed subject matter.

Independent Claim 20

The Office Action rejected independent Prior Claim 20 under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird. Regarding independent Prior Claim 20, the Office Action stated:

Re claim 20 and 37: The limitations of claim 20 have been met by the combination of the limitations of claims 11-17.

However, such combination does not address the following elements of independent Prior Claim 20: (a) "each modifier associated with at least one subsequent play of the primary wagering game, at least one modifier associated with a plurality of subsequent plays of the primary game, and each modifier adapted to modify at least one function of the primary game"; (b) "a display device"; (c) "activate the selected modifier for the subsequent plays of the primary wagering game that are associated with the selected modifier"; and (d) "enable the player to play at least one subsequent primary wagering game, wherein the activated modify is applied to the primary wagering game for each of the subsequent plays of the primary wagering game associated with the activated modifier." Hughs-Baird does not anticipate nor render obvious such claimed subject matter. At least for this reason, Applicant requests the withdrawal of such rejection of Prior Claim 20.

Independent Claim 37

The Office Action does not specifically reject independent Prior Claim 37. However, regarding independent Prior Claim 37, the Office Action states:

Re claim 20 and 37: The limitations of claim 20 have been met by the combination of claims 11-17.

As best understood by Applicant, such statement contains a typographical error and should have been stated as "the limitations of claim 20 and 37 have been met by the combination of claims 11-17." Regarding independent Prior Claim 37, the Office Action does not address the following elements: (a) "wherein each modifier is associated with at least one subsequent play of the primary wagering game, at least one modifier is associated with a plurality of subsequent plays of the primary wagering game and each modifier is adapted to modify at least one function of the primary wagering game"; (b) "a triggering event in said primary wagering game, wherein after the occurrence of said triggering event"; (c) "the selected modifier is activated for the plurality of subsequent plays of the primary wagering game that are associated with the selected modifier"; (d) "the player is enabled to play at least one subsequent primary wagering game"; and (e) "modify wherein the function of the primary wagering game that said activated modifier is associated with is modified for the plurality of subsequent plays of the primary wagering game that the modifier is activated." Hughs-Baird does not anticipate nor render obvious such claimed subject matter. At least for this reason, Applicant requests the withdrawal of such rejection of Prior Claim 37.

Independent Claim 38

The Office Action does not specifically reject independent Prior Claim 38. Regarding independent Prior Claim 38, the Office Action states:

Re claim 38 and 47: The limitations of claim 38 have been met by the combination of claims 1 and subsequent dependent claims 1-9[sic].

However, regarding independent Prior Claim 38, the Office Action does not address the following elements: (i) "wherein each of said modifiers is associated with at least one subsequent activation of the reels and at least one of said modifiers is associated with a plurality of subsequent activations of the reels;" (ii) "activating said selected modifier for the plurality of subsequent activations of the reels that said selected modifier is associated with if said modifier activator symbol is displayed on said active payline;" and (iii) "repeating steps (b) to (e) at least once." Hughs-Baird does not

anticipate nor render obvious such claimed subject matter. At least for this reason, Applicant requests the withdrawal of such rejection of Prior Claim 38.

Independent Claim 47

Regarding independent Prior Claim 47, the Office Action stated:

Re claim 38 and 47: The limitations of claim 38 have been addressed by the combination of claims 1 and the subsequent dependent claims 1-9[sic].

As best understood by Applicant, such statement contains a typographical error and should have been stated as "the limitations of claim 38 and 47 have been addressed by the combination of claims 1 and the subsequent dependent claims 2-9." Regarding independent Prior Claim 47, the Office Action does not address the following elements: (i) wherein each of said modifiers is associated with at least one subsequent play of the primary wagering game and at least one modifier is associated with a plurality of subsequent plays of the primary wagering game; (ii) activating said selected modifier for the plurality of subsequent plays of the primary wagering game that said selected modifier is associated with if the player obtains said modifier activator in the primary wagering game; and (iii) repeating steps (a) to (c) at least once. Hughs-Baird does not anticipate nor render obvious such claimed subject matter. At least for this reason, Applicant requests the withdrawal of such rejection of Prior Claim 38.

Remaining Dependent Claim Rejections

The Office Action rejected dependent Prior Claims 4, 5, 16, 17, 23 and 24 under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird in view of U.S. Patent Publication No. 2003/0060265 to Webb ("Webb"). The Office Action stated the following: "Claim rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (U.S. Patent 6,692,355). The Office Action does not specifically recite any claims in such rejection. The Office Action discusses dependent Prior Claims 34, 41 and 50 after such rejection. As best understood, the Office Action intended to reject such claims under 35 U.S.C. 103(a) as being unpatentable over Hughs-Baird in view of Baerlocher. The Office Action rejected dependent Prior Claims 14, 15 and 33 under 35

U.S.C. 103(a) as being unpatentable over Hughs-Baird in view of U.S. Patent No. 6,634,945 to Glavich, et al. ("Glavich"). Applicant disagrees with and traverses such rejections for reasons similar to those submitted with respect to independent Prior Claims 1, 18, 20, 37, 38 and 47. For the foregoing reasons, Applicant requests withdrawal of such rejections.

As best understood, the Office Action suggests that certain elements of the apparatus claims are not in structural form. If the Examiner is referring to the memory device or processor elements, Applicant submits that the independent apparatus Prior Claims are, in fact, distinguished from the prior art in terms of structure.

The M.P.E.P. supports Applicant's position. Section 2106.01 of the M.P.E.P states:

When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium M.P.E.P. § 2106.01.

[A] claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. M.P.E.P § 2106.01.

USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claims remain statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. M.P.E.P § 2106.01.

When a computer program is recited in conjunction with physical structure, such as a computer memory, USPTO should treat the claim as a product claim. M.P.E.P § 2106.01.

For the forgoing reasons, Applicant submits that the apparatus Prior Claims are patentably distinguished from the cited references in terms of structure. In addition, for all of the reasons provided above, Applicant submits that the Prior Claims are patentably distinguished from the cited references.

Amendments

Despite such traversal, Applicant has amended independent claims 1, 18, 20 and 37 to clarify the structural claim language and advance the prosecution of this application. Independent claim 1 recites, among other elements, "at least one display device; at least one processor; and at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device to"

Independent claim 18 recites, among other elements, "at least one display device; at least one processor . . . at least one memory device which stores a plurality of instructions, which when executed by the at least one processor after the triggering event occurs, cause the at least one processor to operate with the at least one display device to"

Independent claim 20 recites, among other elements, "at least one processor; and at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the display device to"

Independent claim 37 recites, among other elements, "at least one display device; at least one input device; at least one processor; at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device and the at least one input device to"

Applicant submits that Hughs-Baird, Webb, Baerlocher, and Glavich do not separately or collectively disclose the claimed subject matter of such claims. For the foregoing reasons, Applicant submits that all of the claims are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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